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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER				
AHMED, AFFAF				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/787,208

**Applicant(s)**

MODI, MANAW

**Examiner**

AFAF AHMED

**Art Unit**

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Status of Claims*

1. This action is in reply to the Applicant's amendment filed on 03/19/2008.
2. Claims 4, 21 and 23 have been amended and objection is withdrawn.
3. Claims 1-39 are currently pending and have been examined.
4. Examiner corrects a typographic error for "***Claims Rejection - 35 USC § 102. Claims 1-3, 6-8, 10-13, 17-19, 21, 22, 25-32 and 34 are rejected under 35 U.S.C. 102 (e)***" is intended to be 102 (b) rejection.
5. Examiner took OFFICIAL NOTICE on claims 14 and 33, Applicant did not properly traverse OFFICIAL NOTICE, therefore it is accepted as prior art.

### *Response to Applicant's Arguments*

6. Applicant's amendments and arguments filed on 03/19/2008 have been fully considered and discussed in the next section.
7. With regard to claim 3, Examiner respectfully thanks Applicant for clarifying claim 3 and withdraws 35 USC § 112 second paragraph rejection.
8. Applicant's amendments and arguments with regard to claims 11-3, 7-13, 15-22, 26-32 and 34-39 have been considered, but they are not persuasive.
9. Applicant argues that Todd does not disclose "***monitoring transactions performed using the first and second financial accounts over a predetermined transaction monitoring period.***" However, Todd in at least paragraph 32 discloses a system that has an account sector for storing account information including a plurality of account records individually associated with "accounts of the individuals" and in at least and in paragraph 45 Todd, discloses monitoring transactions completed by users and incrementally adding value to each account each time a user uses the financial services to complete an approved transactions, which is clearly stating that each individual has more than one account with financial services. Further more, Todd in at least paragraph 73, discloses an input from associated record account record provides an accumulated total amount for transactions occurring during a current billing cycle or other predetermined time, which is clearly stating that transactions are monitored for certain accounts over a predetermined period of time.

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10. With regard to claims 4-6 and 23-25, Applicant argues that “*Atkins fails to cure the deficiencies of Todd*”. However, Examiner respectfully disagrees with Applicant’s statement with regard to Todd deficiencies because as stated in item 8 above, Todd does not have any deficiencies. Atkins’s system for the operation and management of one or more financial accounts through the use of digital communication and computation system for exchange investment and borrowing is used to address the limitations of receiving and applying an incentive to an account if the forecast goal is met. Applicant argues that “*Examiner has not established a prima facie case of the obviousness in rejecting claims 4-6 and 23-25 in view of Todd and Atkins.*” Examiner respectfully disagrees with Applicant’s statement and directs Applicant to page 5 of the OFFICE ACTION, item 10. Further more, in response to Applicant’s argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching suggestion, or motivation to do so found either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 US PQ2d 1941 (Fed. Cir. 1992).

11. With regard to claims 14 and 33, Applicant argues that “*Examiner’s OFFICIAL NOTICE fails to cure the deficiencies of Todd.*” However, Examiner respectfully disagrees with Applicant’s statement with regard to Todd’s deficiencies because as stated in item 8 above, Todd does not have any deficiencies. OFFICIAL NOTICE was taken to address the limitations that it is old and well known in finance and banking art that consumers must approve any financial transaction before it takes place, including giving authorization to transfer transactions from one financial account provider to another financial provider. For example, automatic direct deposit or automatic bill-payments where consumers authorize one financial provider to transfer certain amount of money to another financial provider to insure that transferring funds or transactions are performed in a secure manner, where a consumer does not physically have to make a trip to a bank.

### ***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-3, 6-8, 10-13, 17-19, 21, 22, 25-32 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Todd, US Pub No: 2003/0061093 A1.

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As per **claims 1, 21 and 38**, Todd teaches:

- *monitoring transactions performed using the first and second financial accounts over a predetermined transaction monitoring period; determining whether the monitored transactions meet at least one predetermined condition; and applying an incentive to the first financial account based on the predetermined condition (see at least paragraphs 45 and 73).*

As per **claim 2 and 22**, Todd teaches:

- *collecting, by the first financial account provider, transaction information associated with each of the transactions from at least one of: the user, a merchant associated with a transaction with the user, a server system that collects the transaction information, and the second financial account provider (see at least paragraph 48).*

As per **claim 3**, Todd teaches:

- *configuring the first financial account based on input received from the user (see at least paragraph 51).*

As per **claims 8,10,11,18, 19, 27, 29, 30 and 37**, Todd teaches:

- *applying variety of incentives based on different category of transactions (see at least paragraphs 25 - 27).*

As per **claims 7, 9, 20, 26 and 28**, Todd teaches:

- *monitoring transactions information for each account (see at least paragraph 17 and paragraph 19).*

As per **claims 12 and 31**, Todd teaches:

- *determining whether any of the transactions are associated with the second financial account (see at least paragraph 12); and*
- *transferring any second financial account transactions to the first financial account based on the determination (see at least paragraph 20).*

As per **claims 15 and 34**, Todd teaches:

- *wherein the incentive includes at least one of adjusting an interest rate for the first financial account, adjusting a credit limit for the first financial account, adjusting an account fee associated with the first financial account, and adding reward points to*

*accumulating reward point total associated with the first financial account (see at least paragraphs 74-79).*

As per **claims 16 and 35**, Todd teaches:

- *wherein the incentive is more attractive to the user when more of the transactions are associated with the first financial account as opposed to the second financial account (see at least paragraph 3).*

As per **claims 17, 18, 36 and 37**, Todd teaches:

- *providing an incentive report to the user based on the applied incentive;*
- *wherein the incentive report includes information associated with incentives that may have been applied to the first financial account based on different types of the predetermined (see at least paragraph 53).*

As per **claims 13 and 32**, Todd teaches:

- *providing payment for the second financial account transactions from the first financial account provider to the second financial account provider and adding a total transaction amount associated with the second financial account transactions to a balance associated with the first financial account (see at least paragraph 26).*

As per **claim 39**, Todd teaches:

- *monitoring transactions performed using the first and second financial accounts over a predetermined transaction monitoring period; determining whether the monitored transactions include at least one transaction associated with the second financial account (see at least paragraphs 17,19 and 73); and*
- *providing payment for the second financial account transactions from the first financial account provider to the second financial account provider and applying a total transaction amount associated with the second financial account transactions to a balance associated with the first financial account (see at least paragraph 26).*

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art

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are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claims 4, 5, 6, 23, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd, US Pub No: 2003/0061093 A1 in view of Atkins US Pat No: 5,644,727.

**Claims 4, 5, 6, 23, 24 and 25:**

Todd discloses the limitations as shown above.

Todd does not disclose, but Atkins, however, does disclose:

- *receiving a forecast goal and determining if the forecast goal is met* (see at least column 7, lines 30 – 45);and
- *applying an incentive to the first account when the forecast goal is met* (see at least column 9, lines 24 -39).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Todd's rewarding customers of financial services providers with Atkins's technique of managing one or more financial accounts with the motivation of tracking bonuses and rebates that will effect and enhance consumers personal financial planning.

17. Claims 14 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd, US Pub No: 2003/0061093 A1 in view of Official Notice.

**Claims 14 and 33:**

Todd discloses the limitations as shown above.

Todd does not disclose:

- *wherein the user gives authorization to the first financial account provider to transfer the second financial account transactions to the first financial account*

However, Examiner takes OFFICIAL NOTICE, that it is old and well known in transferring financial fund art; consumers must approve any financial transaction before it takes place. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Todd's system of transferring fund with users' authorization with the motivation of transferring transactions in a secure manner.

### ***Conclusion***

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

19. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS from the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Affaf Ahmed whose telephone number is 571-270-1835. The examiner can normally be reached on Monday - Friday, 8:30 am-6:00 pm est, alt Fridays off.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached at 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

22. Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AA